

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-9 are currently pending. No claim amendments are presented, thus, no new matter is added.

In the outstanding Office Action, Claims 1, 2, and 9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lee et al. (U.S. Pub. No. 2003/0112773, hereafter "Lee"); Claims 6 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of Applicants' Admitted Prior Art (AAPA); and Claims 3-5 and 7 were objected to as being dependent upon a rejected base claim, but containing allowable subject matter.

Applicants thank the examiner for the indication of allowable subject matter. However, Claims 3-5, and 7 are maintained in dependent form because Applicants believe that base claims 1, 2, and 9 include allowable subject matter as discussed below.

With respect to the rejection of Claim 1 under 35 U.S.C. §103(a), Applicants respectfully traverse this ground of rejection. Claim 1 recites, *inter alia*,

a determination unit configured to determine a communication quality of the shared control channel; and

a transmission power controller configured to control the transmission power of the shared control channel based on a transmission power of a dedicated channel accompanying the shared control channel and the communication quality of the shared control channel received from the determination unit.

Lee is directed to a method of controlling the transmission power of the high-speed downlink shared channel (HS-SCCH) in a high speed downlink packet access (HSDPA) system. Lee describes a base station receiving a transmit power control (TPC) command from a mobile station and determining a transmission power of a downlink dedicated physical channel (DL DPCH) based on the TPC command, and determining transmission power of the

HS-SCCH channel transmitted to each mobile station by using a power offset value related to transmission power of the DL DPCH (see para. [0021] and [0046]). Therefore, in Lee, the determination of transmission power of the downlink shared control channel (HS-SCCH) is based on the power control of the downlink dedicated physical channel.

In other words, Lee describes controlling the transmission power of the shared control channel based on a transmission power of a dedicated channel, but not on both the transmission power of the dedicated channel *and the communication quality of the shared control channel received from a determination unit*.

The Office Action acknowledges that Lee does not disclose a determination unit configured to determine a communication quality of the shared control channel. To remedy this deficiency, the Office Action states the following:

“However, Lee discloses that in order to prevent an increase in an error rate of HS-SCCH, power of HS-SCCH should be increased (page 3, 55<sup>th</sup> paragraph). Herein, the error rate of HS-SCCH must be monitored in order to determine the error rate. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to monitor error rate of HS-SCCH thereby transmission power of HS-SCCH can be managed effectively.” (See Office Action, at page 3)

Therefore, it appears that the Office Action is stating that it would be obvious to modify Lee to incorporate the claimed determination unit. The Office Action gives as the reason for this modification that because Lee is trying to prevent an increase in an error rate of HS-SCCH, then it “must” also have the means to monitor the error rate.

First, the logic of the examiner’s motivation to modify Lee is unclear. The examiner first acknowledges that Lee does not disclose the claimed “determination unit.” Then the Office Action takes the position that it would be obvious to modify Lee to have the determination unit because the error rate “must” be monitored. Therefore, the examiner appears to be saying that Lee requires the claimed “determination unit” even though Lee

itself never provides any reason that it requires one. Additionally, Applicants respectfully submit that if the error rate of HS-SCCH “must” be monitored in Lee, then Lee would have actually disclosed this feature.

On the contrary, Lee discloses “in order to **prevent** an increase in an error rate of HS-SCCH **that can possibly occur** in the soft handover of DL DPCH, the transmission power of HS-SCCH should be increased.” (see para. [0055]). First, Lee states that the increase in error rate of the HS-SCCH can “possibly occur in the soft handover,” which indicates that Lee presumes an error rate is increased without actually needing to check for an increase in error rate. Second, Lee later explains that “when determining the power offset of HS-SCCH, different power offset values are used **according to whether DL DPCH is in soft handover or not.**” (See para. [0057]). Lee then proceeds to describe a method in which the RNC sends one of three different power offset values based on the type of soft handover being performed. (See para. [0058], [0059], and [0064]). Thus, the decision on whether to increase the power of the HS-SCCH in Lee is based on whether the DL DPCH is performing a soft handover and what type of handover is involved. **However, the decision is not based on a determination of the actual error rate of the HS-SCCH.** Therefore, a determination unit to determine the error rate is not required to perform the method described in Lee, and there is no reason that it “must” be in Lee as was asserted in the Office Action.

Therefore, without citing to any suggestion in Lee or to any secondary reference, the examiner appears to be using impermissible hindsight reasoning alone to incorporate the “determination unit” in Lee.

As stated in MPEP 2145.X.A:

However, “[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made **and does not include knowledge gleaned only from applicant’s**

*disclosure*, such a reconstruction is proper." In re McLaughlin 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). (Emphasis added).

Furthermore, the language used in the Office Action that "the error rate of HS-SCCH must be monitored in order to determine the error rate," also indicates that the examiner may be asserting that the claimed determination unit is inherently in Lee.

However, the Federal Circuit has stated that "to establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter *is necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. *The mere fact that a certain thing may result from a given set of circumstances is not sufficient.*'"<sup>1</sup> (Emphasis added).

As discussed above, a means of monitoring the error rate of the HS-SCCH channel is not necessarily present in Lee (i.e., it is not required in performing the method of Lee) and is thus not inherently in Lee.

Thus, Applicants submit that the examiner's rejection of Lee under 35 U.S.C. §103(a) is improper and must be withdrawn.

Therefore, Applicants respectfully submit that Lee fails to disclose or suggest "**a determination unit configured to determine a communication quality of the shared control channel**; and a transmission power controller configured to control the transmission power of the shared control channel based on a transmission power of a dedicated channel accompanying the shared control channel **and the communication quality of the shared control channel received from the determination unit**," as defined by Claim 1.

Therefore, Applicants respectfully submit that Claim 1 (and all associated dependent claims) patentably distinguishes over Lee.

---

<sup>1</sup> In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The AAPA has been considered but fails to remedy the deficiencies of Lee with regard to Claim 1. Thus, Applicants respectfully submit that Claim 1 (and all associated dependent claims) patentably distinguishes over Lee and the AAPA, either alone or in proper combination.

Independent Claim 9 recites a method with features similar to those of Claim 1 discussed above. Thus, Applicants respectfully submit that amended Claim 9 patentably distinguishes over Lee and the AAPA, either alone or in proper combination.

With regard to dependent Claim 2, Claim 2 recites, *inter alia*,

the transmission power controller is configured to control the power offset in accordance with the communication quality of the shared control channel.

With regard to the above-mentioned feature of Claim 2, the Office Action cites to para. [0055] of Lee and takes the position that Lee describes “in order to prevent an increase in an error rate of HS-SCCH that can possibly occur in the soft handoff of DL DPCH, the transmission power of HS-SCCH should be increased.” However, the Office Action is only citing to the portion of Lee already discussed above which describes increasing the power of the HS-SCCH to prevent an increase in error rate during a soft handover. This portion of Lee says nothing about what is actually used as a basis for controlling the power offset.

Applicants note that in other portions of Lee, it is very explicit in what is used to control the power offset when increasing the transmission power of the HS-SCCH. As discussed above, Lee describes that “when determining the power offset of HS-SCCH, different power offset values are used ***according to whether DL DPCH is in soft handover or not.***” (See para. [0057]). Lee then describes an RNC sending one of three different power offset values based on the type of soft handover being performed. (See para. [0058], [0059], and [0064]). Thus, the power offset value in Lee is based on whether the DL DPCH is performing a soft handover and what type of handover is involved. However, Lee clearly

does not describe controlling the power offset in accordance with the communication quality of the shared control channel, as defined by Claim 2. On the contrary, Lee fails to disclose even the determination unit of Claim 1, which is used to determine the communication quality recited in Claim 2. Therefore, Lee cannot have explicitly disclosed "controlling the power offset in accordance with the communication quality of the shared control channel," and the Office Action has also not provided any articulation on why this feature of Claim 2 is otherwise obvious.

Thus, Applicants submit that the examiner's rejection of Claim 2 under 35 U.S.C. §103(a) is improper and must be withdrawn.

The AAPA has been considered but fails to remedy the deficiencies of Lee with regard to Claim 2. Thus, Applicants respectfully submit that Claim 2 patentably distinguishes over Lee and the AAPA, either alone or in proper combination, for at least the foregoing reasons.

Consequently, in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.


Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Customer Number

**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 08/07)



Bradley D. Lytle  
Attorney of Record  
Registration No. 40,073

Sameer Gokhale  
Registration No. 62,618